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In re Application of
Riley
Application No. 10/726,524
Filed: December 4, 2003
Attorney Docket No. 10442-0100DV

OFFICE OF PETITIONS
ON PETITION

This is a decision on the petition filed May 4, 2004, requesting acceptance of a substitute specification submitted with the instant petition, in response to a Notice of Omitted Items in a Nonprovisional Application, mailed March 4, 2004, and accordation of a December 4, 2003 filing date for the substitute specification. The petition is being treated under 37 CFR 1.53(e).

The application was filed on December 4, 2003. On March 4, 2004, the Office of Initial Patent Examination mailed a "Notice of Omitted Items in a Nonprovisional Application" (Notice) stating that the application had been accorded a filing date of December 4, 2003, and advising applicant that pages 4, 5, and 21 of the specification appeared to have been omitted.

In response, the present petition was filed. Petitioner requests that the Office accept a substitute specification that includes omitted pages 4, 5, and 21 and accord a December 4, 2003 filing date to the substitute specification because the omitted pages were originally filed in prior application No. 09/987,234, the entire disclosure of which was incorporated by reference at the time of this application's December 4, 2003 filing.

The petition under 37 CFR 1.53(e) is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioner neither asserts that the missing pages were actually deposited in the PTO on December 4, 2003 with the other application papers, nor requests a later filing date.

Instead, applicant seeks to add the omitted pages to the present application on the basis that the pages are not new matter. However, no petition is necessary for that purpose. Additional pages of

specification may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP § 608.02(a).

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

If applicant desires that pages 4, 5, and 21 be added to the specification, the appropriate procedure is by way of amendment requesting the entry of the pages. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Accordingly, the petition is inappropriate and is subject to dismissal.

The petition fee will not be refunded, since the petition was not necessitated by any error on the part of the Office.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of December 4, 2003. The substitute specification containing pages 4, 5, and 21 will **not** be processed at this time.

Thereafter, the application will be forwarded to Technology Center 1700 for examination in due course.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.



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